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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/153,577	09/15/1998	DANIEL J. ZIGMOND	3382-50875/S	5732

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EXAMINER

PEYTON, TAMMARA R

ART UNIT

PAPER NUMBER

2182

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/153,577

Applicant(s)
ZIGMOND ET AL.

Examiner
Tammara Peyton

Art Unit
1234



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/07/2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 7, 11-16, 21, 22, 24-28, and 30-39 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 7, 11-16, 21, 22, 24-28, and 30-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 6, 7, 13, 14, and 25-28, are rejected under 35 U.S.C. 102(e) as being anticipated by *Macrae et al.*, (WO 98/17064).

3. As per claim 6, *Macrae* teaches a method of operating a screen to transition between display of a television signal and display of auxiliary data from an auxiliary data network that delivers data apart from the television signal [via Internet Source Provider, Fig. 1], comprising:

displaying a television signal [Fig. 1];

in response to link data conveyed with the television signal, displaying with the displayed television signal an icon [95, Fig.2] , said icon indicating the availability of associated auxiliary data from the auxiliary data network [pg. 5, lines 6-10] ; and

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responsive to a signal from a viewer during the displaying the icon displaying a graphical control panel [See Figs. 3,4] operable by the viewer to cause display of the auxiliary data associated with the icon. [Abstract, pg. 5, lines 10-23]

4. As per claims 7, *Macrae* teaches displaying said icon for a predetermined period, and thereafter removing the displayed icon from the screen. [pg. 5, lines 8-10]

5. As per claim 13, *Macrae* teaches displaying in the graphic control panel a title of the auxiliary data associated with the icon. [See Fig. 3, 4]

6. As per claim 14, *Macrae* teaches that responsive to a second signal from the viewer during the displaying of the graphical control panel, displaying the auxiliary data.

7. As per claims 25 and 26, *Macrae* discloses receiving the auxiliary data and television signal and seeing if they can be identified by the system's memory and recalling at least part of the memory for displaying to the screen.

8. As per claim 27, *Macrae* teaches that responsive to a second signal from the viewer during the displaying the control panel, ending the displaying the control panel.

9. As per claim 28, *Macrae* teaches a method in which the control panel includes plural graphical controls, one for causing display of the auxiliary data, and one for ending the displaying the control panel.

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Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 11, 12, 15, 16, 21, 22, 24, 30-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Macrae et al.*, (WO 98/17064) and *Broadwin et al.*, (US 5,929,850).

12. As per claims 15, 16, 21, 22, 24, 30, and 35-38, *Macrae* teaches a method of operating a screen transition between display of a television advertising message and display of additional information from the Internet relating to the subject of the advertising message, comprising:

displaying a televised advertising message;

in response to logical address link data conveyed with the televised advertising message, displaying with said televised advertising message an icon; and

in response to user selection of said icon, displaying a graphical control panel that presents to the user a plurality of options selectable by the user, a first option selectable by the user to indicate desire to return to the displaying the televised advertising message, and a second option selectable by the user to indicate desire to view additional information from the Internet relating to the subject of said advertising message. [pgs. 5-18]

13. *Macrae* teaches that in response to a selection of said icon, a graphical control panel [Figs. 3, 4] is display that presents to the user a plurality of selectable options. One option is to

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indicate a desire to view additional information from the Internet relating to the subject of said advertising message. *Macrae* does not expressly teach wherein one of the option is a desire to return to the televised advertising message; however, *Macrae* teaches that if an icon appears during a television program and the user presses an 'INFO' button, the graphical control panel will appear and give the user the option to store an Internet address associated with the icon and not view additional information from the Internet relating to the subject of said advertising message. Presumably, the user is returned to the television program after selecting the option to store the Internet address. Nonetheless, *Broadwin* teaches an interactive television system that displays various selection options for linking images to an associated interactive program. Specially, *Broadwin's* system displays one or more selection options on a television screen as it related on an image. If the link is selected a graphical control panel is displayed. The user is given the option to view additional information about the image related to the program or return to viewing the original program thereby ending the display of the panel. [*Broadwin*, col. 18, lines 38-55, col. 2, lines 25-col. 7, col. 9, lines 53-55, Figs. 14, Step G , 16, and 18]

14. Both *Broadwin* and *Macrae* draw to the same conclusion of displaying information associated with the current televised content, therefore, it would have been obvious to one of ordinary skill at the time the invention was made to implement *Broadwin's* method to *Macrae* thereby allowing a user to return to viewing the televised content after selecting an icon that was previously displayed. Doing so would add and expand the flexibility of *Macrae*.

15. As per claims 11, 12, 33, and 34, *Macrae* teaches of receiving and showing an icon at a predetermined time as it relates to a specific program or channel, it would have been obvious that

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after the specific program has ended that particular icon related to the show is removed from the screen.

16. As per claims 31, 32, and 39, *Macrae* obviously teaches that the icon is translucent in order to not inhibit the viewer's program during the broadcast.

17. Applicant's arguments filed on 10/07/02 have been fully considered but are moot based on the new grounds of rejections.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (703) 306-5508. The examiner can normally be reached between 8:00 - 4:30 from Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Gaffin, can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9600.

Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Mailed responses to this action should be sent to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231.

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Faxes for formal communications intended for entry should be sent to:

(703) 746-7238, After Final (703) 746-7239

or, for informal or draft communications, to:

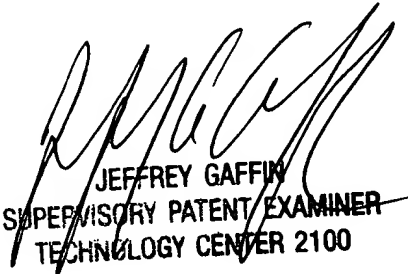
(703) 746-7240 (please label "PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to:

Crystal Park II, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).

Tammara Peyton

December 13, 2002


JEFFREY GAFFIN
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